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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,482	07/10/2000	Albert K. Chin	4589	1945

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/614,482	Applicant(s) CHIN, ALBERT K.	
	Examiner Michael Thaler	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,13 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,13 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2004 has been entered.

Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 4.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The location along the cannula where the first lumen extends beyond the second lumen is near transition contour 152 (which is not part of the hood). Note page 7, line 22 to page 8, line 4 of the specification. However, claim 13 indicates that the hood includes the transition contour, making it unclear which transition contour is intended to be claimed. The tapered transition contour of the hood is not near the

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location along the cannula where the first lumen extends beyond the open distal end of the second lumen.

Claims 7, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin (5,916,233) in view of Jones (5,503,616). Chin shows first lumen 25 for housing an endoscope 27 therein, transparent tip 13 and second lumen (one of the lumens described in col. 3, lines 29-32) eccentric the first lumen and having an open distal end 35 for housing a surgical instrument for performing procedures on tissue viewed through the transparent tip 13. The open distal end 35 of second lumen is positioned intermediate the proximal and distal ends of the first lumen since the transparent tip 13 extends significantly distally beyond the open distal end 35 of second lumen as seen in figures 2A, 3A-C and 4A-C. Chin fails to show a flexible hood coupled to the distal end of the second lumen. However, Jones teaches that a lumen 20 for housing a surgical instrument on an endoscopic device should be elastomeric and collapsible in order to allow a smaller scope to gain access to a body cavity (col. 2, lines 1-13 and col. 4, lines 37-56). It would have been obvious to make the second (instrument) lumen of Chin elastomeric and collapsible so that it too would have this advantage. With this modification, the Chin device would

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include a second lumen (the main portion of the collapsible lumen) and a flexible and resilient hood (the distal portion of the collapsible lumen) which is coupled (by a unitary connection) to the distal end of the second lumen. Further, the hood would have a tapered transition orientation when the surgical instrument is retracted within the second lumen since the main portion of the hood would be collapsed (since no instrument would be within this portion) while the second lumen would be expanded (since the instrument would be within this portion to expand this portion of the elastomeric lumen in the manner described in col. 4, lines 42-46) and the transition between these two portions would be tapered.

Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive. The allegation that the collapsible channel of Jones offers no tapering sectional area as claimed is incorrect. As pointed out in the rejection, a tapered transition orientation is inherently formed in the Jones hood incorporated into the Chin device when the surgical instrument is retracted within the second lumen since the main portion of the hood would be collapsed (since no instrument would be within this portion) while the second lumen would be expanded (since the instrument would be within this portion to

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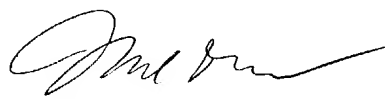
expand this portion of the elastomeric lumen) and the transition between these two portions would be tapered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
5/13/04


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731